

REMARKS

This Amendment and Response is made in reply to the Office Action mailed October 4, 2010, in which the Examiner:

Rejected claims 1-3, 5, 6, 8, 21, 22 and 25-32 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement; and

Rejected claims 1-3, 5, 6, 8, 21, 22 and 25-32 under 35 U.S.C. § 112, second paragraph, as indefinite.

Applicant respectfully addresses and traverses each of the foregoing rejections below. Claims 1-3, 5, 6, 8, 21, 22 and 25-32 are pending in the subject application. Claims 1 and 25 are independent claims. Claims 1 and 25 have been amended herewith. Paragraph 0033 of the subject Application (paragraph 0035 of the published Application) has been amended herewith.

I. Background

Applicant gratefully acknowledges and wishes to thank the Examiner for withdrawing the rejections of claims 1-3, 5, 6, 8, 21, 22 and 25-32 under 35 U.S.C. § 112, first paragraph, set forth in the Office Action mailed December 28, 2009, based on the arguments set forth in Applicant's Amendment and Response to Office Action dated June 28, 2010.

Applicant further gratefully acknowledges and wishes to thank the Examiner for participating in an interview with Applicant and Applicant's representative on January 26, 2011. During the interview, Applicant and the Examiner discussed the support for the inventions recited in claims 1-3, 5, 6, 8, 21, 22 and 25-32 in the specification, claims and drawings as filed, and the definiteness of the language of claims 1-3, 5, 6, 8, 21, 22 and 25-32, including potential amendments to the claims which would place the subject Application in condition for allowance.

II. Rejections based on 35 U.S.C. § 112 – Written Description

Regarding the outstanding rejections of claims 1-3, 5, 6, 8, 21, 22 and 25-32 under 35 U.S.C. § 112, first paragraph, as failing to satisfy the written description requirement, the Examiner argues that the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the pertinent art that the Applicant, at the time the application was filed, had possession of the claimed inventions. Office Action, pages 2-3. Specifically, the Examiner argues that the written description requirement has not been satisfied for three particular reasons. First, the Examiner argues that claims 1 and 25 fail to set forth the composition or structure of the container and the symbol. Second, the Examiner argues that the Applicant has not set forth or described the “environment where the receptacle is situated. Third, the Examiner argues that the Applicant has not provided guidance as to the meaning of “water reactivities,” or how one of ordinary skill in the art would construct a container and symbol to produce the “claimed ‘water reactivities’ effect.” Office Action, page 3.

For at least the following reasons, Applicant respectfully disagrees with the Examiner.

As is set forth in Section 2163 of the Manual of Patent Examining Procedure, “[t]here is a strong presumption that an adequate written description of the claimed invention is present when the application is filed.” M.P.E.P. § 2163, *citing In re Wertheim*, 541 F.2d 257, 263 (C.C.P.A. 1976) (emphasis added). The written description is presumed to be adequate unless or until sufficient evidence or reasoning to the contrary has been presented by the Examiner to rebut this presumption. M.P.E.P. § 2163.04, *citing In re Marzocchi*, 439 F.2d 220, 224 (C.C.P.A. 1971). The Examiner must have a reasonable basis to challenge the adequacy of the written description, and bears the initial burden of presenting – by a preponderance of the evidence – why one of skill in

the art would not recognize descriptions of the inventions defined by the claims in the Applicant's disclosure. *Id.*, citing *Wertheim*, 541 F.2d at 263.

Applicant respectfully submits that the Examiner has failed to meet her burden in this regard. Written description issues generally involve the question of whether the subject matter of a claim is conforms to the disclosure of an application as filed, see M.P.E.P. § 2163.01, and the inventions recited in claims 1-3, 5, 6, 8, 21, 22 and 25-32 clearly conform to the specification, claims and drawings as originally filed with the subject Application. Although the Examiner argues that Applicant has not set forth or described the "environment where the receptacle is located," see Office Action, page 3, Applicant respectfully submits that this term is unequivocally explained to those of skill in the art in the express teachings of the specification and the figures.

At a minimum, paragraph 0029 and Figure 4a of the subject Application clearly instruct those of skill in the art as to the meaning of the "environment where the receptacle is located":

FIG. 4a depicts fluid receptacle assembly 200 after additional of a cold fluid 206 to internal receptacle space 205 of receptacle body 201. The fluid 206 is sufficiently cold to reduce the temperature of receptacle assembly 200 to the condensation point in the environment where receptacle assembly 200 is situated. This causes the formation of condensation beads 207 on the outer surfaces of receptacle body 201 because of the smooth, hydrophobic surfaces of receptacle body 201.

Specification ¶ 0029 (emphasis added); see also Specification ¶¶ 0042 (initiation of coolant flow "cools the exterior wall to the condensation point in the environment where industrial tank 101 is situated"); 0045 ("[w]hen beverage mug assembly 300 is filled with a beverage that is sufficiently cold to cause the exterior of beverage mug assembly 300 to reach the condensation point in the environment where beverage mug assembly 300 is situated, beads of condensation form on mug extensions 316 through 325 because they are hydrophilic").

Indeed, Figure 4a of the subject Application shows an embodiment of the present invention – particularly, the working example of a receptacle body 201 having hydrophobic surfaces and a symbol body 101 having hydrophilic surfaces – in which a difference in water reactivities between a container and a symbol renders the symbol visually distinct from the container when the container holds a fluid and when a temperature of the container is reduced to a condensation point in an environment where the receptacle is situated:

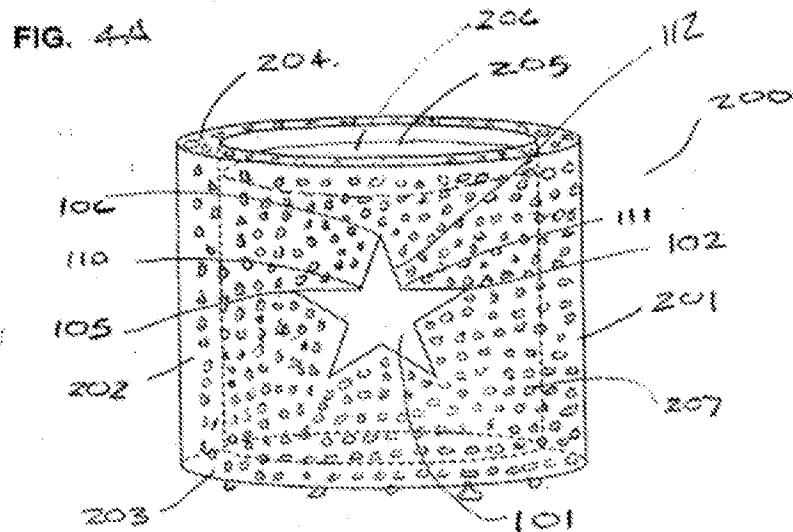


Figure 4A of the Subject Application

See also Specification ¶¶ 0029, 0030 (receptacle assembly 200 having receptacle body 201 with hydrophobic surfaces and symbol body 101 having hydrophilic surfaces).

Similarly, although the Examiner argues that Applicant has not “provide[d] guidance on the meaning of ‘water reactivities,’” see Office Action, page 3, Applicant submits that, at a minimum, paragraph 0033 (as amended) and Figure 4A explain the concept of “water reactivities” with respect to the inventions recited in claims 1 and 25:

Symbols may be fabricated from a wide variety of materials, provided that the color and surface finish be chosen to match the color and surface finish of the fluid receptacle to which the symbols will be affixed,

although color matching is not required where the symbol is transparent or translucent. In addition, the material of which a symbol is fabricated should have a water reactivity that differs from the water reactivity of the fluid receptacle to which the symbol will be affixed. Thus, if a fluid receptacle is fabricated from a hydrophilic material, the symbol should be fabricated from a hydrophobic material. Conversely, if the fluid receptacle is fabricated of a hydrophilic material, the symbol should be fabricated from a hydrophobic material, as discussed in connection with FIGS. 1 through 4A above. A symbol also may be made of a thermosensitive material that changes color with a change in temperature.

Specification ¶ 0033 (emphasis added); see also Specification ¶¶ 0029, 0042, 0045.

Indeed, based on the prosecution history in this matter, there can be no doubt that the term “water reactivity” is supported by the Application as filed. The Examiner has admitted as much: in the Office Action mailed May 16, 2007, the Examiner noted that “[t]he specification clearly indicates that the symbol is visually distinct when there is a different water reactivities [sic] in the materials and when the temperature of the container is reduced to the condensation point.” (Emphasis added.)

Thus, for at least the foregoing reasons, Applicant respectfully submits that the inventions recited in claims 1-3, 5, 6, 8, 21, 22 and 25-32 are more than adequately supported by the written description as filed, and that the rejections thereof are improper.

Nevertheless, in an effort to advance the prosecution of the subject Application, Applicant has amended claims 1 and 25 to recite that the symbol is rendered visually distinct from the container due to the formation of condensation on at least a portion of the receptacle. The foregoing amendments to claims 1 and 25 clearly find support in the written description as filed. See Specification ¶ 0029 (“The fluid 206 is sufficiently cold to reduce the temperature of receptacle assembly 200 to the condensation point in the environment where receptacle assembly 200 is situated. This causes the formation of condensation beads 207

on the outer surfaces of receptacle body 201 because of the smooth, hydrophobic surfaces of receptacle body 201.") (emphasis added); see also FIG. 4A.

Accordingly, for at least the foregoing reasons, Applicant submits that claims 1-3, 5, 6, 8, 21, 22 and 25-32 are adequately supported by the specification, claims and drawings as filed, and respectfully requests that the rejections thereof be withdrawn.

III. Rejections based on 35 U.S.C. § 112 – Indefiniteness

Regarding the rejections of claims 1-3, 5, 6, 8, 21, 22 and 25-32 under 35 U.S.C. § 112, second paragraph, as indefinite, the Examiner argues that claims 1 and 25 fail to set forth the composition or structure of the claimed container, and only claim properties of the container. Office Action, page 3. Applicant respectfully disagrees with the Examiner.

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. M.P.E.P. § 2173.02, *quoting Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986). Indeed, as the Federal Circuit has repeatedly emphasized, the requirement to “distinctly claim” means that the claim must have a meaning discernible to one of ordinary skill in the art, and only when a claim remains “insolubly ambiguous” without a discernible meaning after all reasonable attempts at construction must it be declared indefinite. *Id.*, *quoting Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 U.S.P.Q.2d 1081, 1089 (Fed. Cir. 2004). Definiteness of claim language must be analyzed not in a vacuum but in light of the content of the particular application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Id.* In reviewing a claim for definiteness, an examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of

its scope and provides clear warning to others as to what constitutes infringement of the patent. *Id.*, citing *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 U.S.P.Q.2d 1279, 1283 (Fed. Cir. 2000).

Applicant submits that those of skill in the art would clearly understand what is claimed in amended claims 1 and 25, and that neither amended claim 1 nor amended claim 25, nor the claims depending therefrom, remains “insolubly ambiguous” in view of the disclosure, the prior art or the interpretation thereof by those of skill in the art. For example, those of skill in the art understand that the invention recited in amended claim 1 clearly requires (a) a receptacle comprising a container and a symbol, (b) the symbol and the container having different water reactivities, and (c) the difference in water reactivities between the container and the symbol must be such that the symbol becomes visually distinct when a temperature of the container is reduced to a condensation point in the environment in which the receptacle is situated. When read in view of the disclosure and the facts made of record in this matter – see, e.g., Application, paras. 0029-0032 (receptacles and/or containers); 0027-0028, 0030, 0032-0035, 0040-0041, 0044-0048 (symbols); 0029, 0031, 0035, 0038 (materials with various water reactivities); and 0031-0032, 0044-0047 (differences in water reactivities rendering the symbol visually distinct), see also FIGS. 4a, 5, 7, 8; Appendix A to Response to Office Action filed Jan. 22, 2009 – such terms are both clear and distinct, and are not “insolubly ambiguous.”

Moreover, even if claims 1 and 25 did not clearly recite the structures of the recited receptacle, container and symbol – and Applicant respectfully submits that the structures are clearly recited – Applicant submits that there is no *per se* bar on the use of functional language in claims and, in fact, functional language is expressly endorsed by the Manual for Patent Examining Procedure:

Applicant may use functional language, alternative expressions, negative limitations or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought.

M.P.E.P. § 2173.01 (emphasis added).

Applicant also notes that the position taken by the Examiner in rejecting claims 1-3, 5, 6, 8, 21, 22 and 25-32 as indefinite appears to contravene the express precedent of the United States Court of Appeals for the Federal Circuit, which has held that claims may only be rejected as indefinite when they are “insolubly ambiguous” and incapable of claim construction:

We have held that a claim is not indefinite merely because it poses a difficult issue of claim construction; if the claim is subject to construction, i.e., it is not insolubly ambiguous, it is not invalid for indefiniteness. That is, if the meaning of the claim is discernible, “even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds.”

Bancorp Servs., L.L.C. v. Hartford Life Ins. Co., 359 F.3d 1367, 1371 (Fed. Cir. 2004) (emphasis added, internal citations omitted).

Applicant notes that the Examiner did not, until the seventh Office Action on the merits, express any difficulty in construing the term “water reactivity” in view of Applicant’s disclosure or the facts of record in this matter, and submits that the Examiner must have understood the meaning of the term “water reactivity” in any of the previous Office Actions. Because it is only after reasonable efforts at claim construction prove futile that the claim may be held indefinite, see *Datamize, LLC*, 417 F.3d at 1347, Applicant submits that the Examiner’s prior attempts at construing the claims must have been both reasonable and successful because she was able to identify references and formulate rejections of claims which included this term, without indicating any objection as to its definiteness. See M.P.E.P. § 2173.06.

Furthermore, after another diligent online search, Applicant was unable to identify any case entitled *Ex Parte Slob*, 157 U.S.P.Q. 172, as cited by the Examiner, see Office Action, page 3, or any case standing for the principle that claims which recite “any conceivable combination of ingredients either presently existing or which might be discovered in the future” are indefinite for this reason.

Moreover, Applicant strenuously objects to any suggestion that the claims may not cover future materials which may be developed that have differing water reactivities and thus render a symbol visually distinct after a temperature of the container reaches a condensation point: as the Federal Circuit has held, Applicant need not describe technological developments in the way in which the claimed invention is made that may arise after the patent application is filed.

United States Steel Corp. v. Phillips Petroleum Co., 865 F.2d 1247 (Fed. Cir. 1989).

Finally, as is set forth above, the Examiner herself has previously acknowledged that the inventions recited in amended claims 1 and 25 are clearly understood by those of skill in the art. As the Examiner noted in the Office Action mailed May 16, 2007, “[t]he specification clearly indicates that the symbol is visually distinct when there is a different water reactivities [sic] in the materials and when the temperature of the container is reduced to the condensation point.” (Emphasis added.)

Thus, for the foregoing reasons, Applicant submits that amended claims 1 and 25 particularly point out and distinctly claim the subject matter regarded as the Applicant’s inventions, and respectfully requests that the rejections thereof be withdrawn. For at least the same reasons, Applicant also submits that claims claims 2, 3, 5, 6, 8, 21, 22 and 26-32 – which depend from either claim 1 or claim 25 – also particularly point out and distinctly claim the subject matter regarded as the Applicant’s inventions, and respectfully requests that the rejections thereof be withdrawn.

For the foregoing reasons, Applicant respectfully submits that claims 1-3, 5, 6, 8, 21, 22 and 25-32 are neither unclear, vague, indefinite nor “insolubly ambiguous,” and respectfully requests that the rejections thereof be withdrawn.

IV. Conclusion

Applicant respectfully submits that nothing in the foregoing amendments to claims 1 and 25 and to paragraph 0033 of the Specification constitutes new

Application No. 10/696,373

Office Action mailed October 4, 2010

Amendment and Response to Office Action dated February 1, 2011

matter, and that support for these amendments may be found generally throughout the specification as filed, for example, in paragraphs 0031, 0044, 0047, and in Figures 1 through 4A.

In view of the foregoing amendments and arguments, Applicant submits that claims 1-3, 5, 6, 8, 21, 22 and 25-32 are presently allowable, and respectfully requests that they be passed to issue.

This Amendment and Response is accompanied by a request for a one (1) month extension of time, and the payment of \$65.00 in extension fees therefor. Applicant believes that no additional fees are due in connection with this Amendment and Response.

Respectfully submitted

/ Gregory W. Gorman /

Gregory W. Gorman

473 Wyoming Circle

Golden, CO 80403

Tel.: (303) 478-9233

E-mail: gorman@parkingstripe.com